

## **Remarks**

### **I. Status of the Application and Claims**

As originally filed, the present application had a total of 12 claims. During previous prosecution, claim 5 was cancelled and new claims 13-16 were added. In the present response, claims 2, 11 and 12 have also been cancelled. Thus, the claims now pending are 1, 3, 4, 6-10 and 13-16.

### **II. The Amendments**

Claims 1 and 16 have been amended to clarify the subject matter being claimed. The word "modified" was added to the portions of the claim referring to the nucleotide sequence of DNA (b) to distinguish this from the nucleotide sequence of DNA (a). Claims 8 and 9 were amended so that they are no longer dependent upon cancelled claim 5 and claims 2, 11 and 12 have been cancelled. In addition, minor amendments were made to claims to correct grammatical oversights. Apart from the claims, the specification was amended to better clarify the exact priority documents that have been relied upon for priority.

None of the amendments made herein add new matter to the application, and their entry is therefore respectfully requested.

### **III. Comments Regarding Information Disclosure Statement**

On page 2 of the Office Action, the Examiner indicates that three documents that were previously cited in the Information Disclosure Statement submitted in September 2004 have not been considered because legible copies were not filed. Applicants request reconsideration. Applicants are submitting herewith another copy of the two EP documents that the Examiner has crossed through on the 1449 form returned with the last Office Action. It is respectfully pointed out that the two EP patent publications were acknowledged previously by the PTO (prior Examiner Loeb) as seen from initialed and dated PTO 1449 type form (courtesy copies attached). Applicants further respectfully point out they submitted the ISR and IPER with their U.S. National Phase application when entering the national phase. This is confirmed by PTO PAIR. The ANNEX to the ISR shows the patent family members for one EP patent document includes U.S. Patent No. 5,551,484 and the patent family member for the other EP patent document includes U.S. Patent No. 5,959,176.

Applicants are also submitting a duplicate copy of the third document in the September 2004 IDS and respectfully submit it appears to have been an attachment to the December 3, 2002 Office Action. The third document appears to relate to a sequence that is also printed in U.S. Patent No. 5,959,176. Also enclosed herewith is another 1449 form which lists the three documents being re-submitted. It is respectfully requested that the present Examiner carefully consider each of the documents enclosed herewith and indicate that this has been done by initialing the appropriate lines next to each of the listed documents. Applicants do not believe that an IDS fee is due. However, if such a fee is now due to assure consideration of the earlier cited material, such fee can be charged to our deposit account 06-1135 regarding our order number 7372/70911.

### **The Rejections**

On page 3 of the Office Action, the Examiner rejects all pending claims under 35 U.S.C. § 112, second paragraph. Claims 1 and 16 (and by dependence, claims 3, 4, 6-10 and 13-15) are rejected based upon the allegation that it is unclear what various phrases in part (b) of the claim are intended to modify. In particular, the Examiner suggests that it is unclear whether the phrase “which contains the nucleotide sequence shown in SEQ ID NO:24” refers to “the DNA” or to the “nucleotide sequence in which one or more bases are deleted, substituted, or added in the nucleotide sequence shown in SEQ ID NO:1.”

In response, Applicants have amended claims 1 and 16 without prejudice and without creating any prosecution history estoppel. Applicants believe that there should not be any confusion as to what the phrases used in part (b) of the claim are modifying. For example, it should be clear that the phrase “which contains the nucleotide sequence shown in SEQ ID NO:24” is referring to the modified nucleotide sequence in which one or more bases have been deleted, substituted or added. Applicants therefore respectfully request reconsideration and withdrawal of the rejection under § 112, second paragraph.

The Examiner also rejects claims 8 and 9 because they are dependent upon cancelled claim 5. Claim 10 is rejected because it is also indirectly dependent on claim 5. In response, Applicants have amended claims 8 and 9 so that they are now dependent upon claim 15 rather

than claim 5. It is therefore respectfully submitted that the Examiner's rejection has been obviated.

### Conclusion

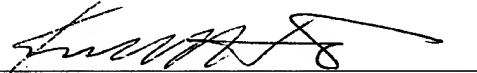
In light of the amendments and discussion above, Applicants respectfully submit that the Examiner's rejection of claims under 35 U.S.C. § 112 has been overcome. It is therefore respectfully requested that this rejection be withdrawn and that the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call one of Applicants' undersigned attorneys.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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Sheet 1 of 1

Application Number  
09/806,197

Applicant  
**NISHIKAWA et al.**

**Filing Date**  
**March 27, 2001**

Group Art Unit  
1636

JUN 01 2001

PATENT DOCUMENTS

**COPY**

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(Including Author, Title, Date, Pertinent Pages, Etc.)

OTHER DOCUMENTS		(Including Author, Title, Date, Pertinent Pages, Etc.)

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DATE CONSIDERED  
23 Nov. 2002

**EXAMINER:** Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

Part of Paper No. 3

Dkt. No.

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Applicant: NISHIKAWA, Satomi et al

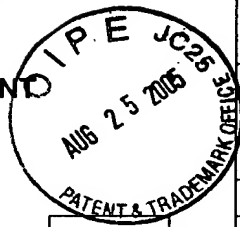
Appln. No.:

Filing Date: March 22, 2001

Examiner: Loeb

Group Art Unit: 1636

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INFORMATION DISCLOSURE STATEMENT  
APPLICANT

Date: March 27, 2001

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## U.S. PATENT DOCUMENTS

Examiner's Initials*	Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR					
	BR					
	CR					
	DR					
	ER					
	FR					
	GR					
	HR					
	IR					
	JR					
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## FOREIGN PATENT DOCUMENTS

		Document Number	Date MM/YYYY	Country	Inventor Name	English Abstract		Translation Readily Available	
						Enclosed	No	Enclose	No
<i>mm</i>	OR	0 824 150 A2	02/1998	EUROPE	S. Torikai				
<i>mm</i>	PR	0 659 884 A2	06/1995	EUROPE	M. Yamamoto				
	QR								
	RR								
	SR								
	TR								
	UR								
	VR								
	WR								
	XR								

OTHER (including in this order: Author, Title, Periodical Name, Date, Pertinent Pages, etc.):

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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.